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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,178

03/12/2004

Joc W. Ferguson

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EXAMINER

REIMERS, ANNETTE R

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

06/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/799,178	FERGUSON ET AL.	
	Examiner	Art Unit	
	Annette R. Reimers	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2007 and 07 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,7-20,22-24 and 26-38 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 4,7-12,22-24 and 26-38 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2004 and 17 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 18, 2007 has been entered.

Election/Restrictions

Applicant's election of species I, figure 4, and sub-species, figure 5, in the reply filed on May 7, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Examiner further acknowledges that applicant believes that claims 4, 7-12, 22-24 and 26-38 read on the elected species/sub-species of figures 4 and 5, respectively. Examiner agrees with applicant that claims 4, 7-12, 22-24 and 26-38 read on the elected species/sub-species of figures 4 and 5.

Claims 13-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 7, 2007.

Double Patenting

Claim 1, 11, 12, 21 and 23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 22-24 of copending Application Number 10/799835. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim an assembly with a distractor with a first and second arm, a first and second anchoring device (fastener), an attaching instrument, and a shaping (milling) instrument. Both inventions are for preparing an intervertebral disc space between a pair of vertebral bodies to receive a prosthesis. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 10-12, 24, 26-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Wright (US Patent Number 6,206,828).

Wright discloses an assembly having a distractor with first and second distraction arms, e.g. 220 and 320, a hollow shaft, e.g. 334, an elongate passage, e.g. 330, and pin, e.g. 384, a first anchoring device, e.g. 350, including a connecting post, a pivot mechanism, a C-shaped opening and an adjustable seat (see figures 9-12) a

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shaping/milling instrument, e.g. 380, a measurement instrument, e.g. ratchet mechanism, and a second anchoring device, e.g. 250 (see figures 1-12).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Wright, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Moreover, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright (US Patent Number 6,206,828) in view of Kim (US Pat Publication 2003/0055430), previously cited by applicant.

Wright discloses the claimed invention except for having an alignment guide. Kim discloses a distractor device with an alignment guide(42, figure 11 a-c). Kim

discloses the alignment guide placed between the first and second anchoring device and teaches that this allows for proper alignment of the assembly on the spine (paragraph 5). It would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Wright with an alignment guide, in view of Kim in order to have proper alignment of the assembly on the spine.

Response to Arguments

Applicant's arguments filed January 18, 2007 regarding the double patenting issue have been fully considered but they are not persuasive. Examiner respectfully disagrees with applicant. Examiner provided applicant with specific claims from copending application 10/799,835, i.e. 1-8 and 22-24, and specific explanations, i.e. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim an assembly with a distractor with a first and second arm, a first and second anchoring device (fastener), an attaching instrument, and a shaping (milling) instrument. Both inventions are for preparing an intervertebral disc space between a pair of vertebral bodies to receive a prosthesis.

Applicant's arguments with respect to claims 4, 7-12, 22-24 and 26-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER